

## **REMARKS**

### **I. STATUS OF THE CLAIMS**

This is intended to be a full and complete response to the Office Action dated April 6, 2006. Claims 1-3, 7, 8, 11, 14-16, and 19-25 are pending in this application. Claims 21-25 have been withdrawn from consideration as drawn to a non-elected invention. Applicants have amended Claim 1. Support for this amendment can be found throughout the specification, such as at page 11, lines 17-19. In view of the amendment and following discussion, the Applicants believe that all claims are in allowable form.

### **II. THE FINAL REJECTION IS IMPROPER**

The Examiner has stated that Applicants previous amendment necessitated the new ground of rejection presented in this Office action, and has accordingly made this action final. However, Applicants previous amendment added the limitations of claim 6 into independent claim 1 such that amended claim 1 is essentially of the same scope of previously pending claim 6. The Examiner's new ground of rejection therefore could not have been necessitated by Applicants previous amendment, since the subject matter of amended claim 1 was already essentially searched and examined as previous claim 6. The MPEP makes clear that:

the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching ...from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will...tend to defeat attaining the goal of reaching a clearly defined issue for an early termination...."

In light of the above, applicants respectfully submit that the amendment to claim 1 did not necessitate the new grounds of rejection and that the finality of the Examiner's rejection is therefore improper and should be withdrawn.

### **III. THE CLAIMED INVENTION IS PATENTABLE OVER ANDERSON**

The Examiner has rejected Claims 1-3, 7, 8, 11, 14-16, 19 and 20 under 35 U. S. C. § 103 (a) as being unpatentable over US 6,550,474 to Anderson et al. ("Anderson"). Applicants

submit that pending Claims 1-3, 7, 8, 11, 14-16, 19 and 20 are not rendered obvious by this reference.

Applicants respectfully submit Anderson fails to teach or suggest any product for application to the skin that comprises a liquid impregnate, in combination with a water-insoluble substrate, and a plurality of microcapsules comprising a microcapsule wall surrounding a liquid core, wherein the microcapsule wall comprises a polyamine, and the microcapsules are distributed about the water-insoluble substrate to facilitate contact with a user's skin.

Anderson is directed to nasal dilators including an aromatic substance to be inhaled through the nose of the wearer. In certain embodiments, the fragrance is encapsulated within any of a wide range of encapsulation types (see Anderson at column 12, line 43 through column 13, line 9), used to physically separate the encapsulated fragrance from the bio-compatible adhesive, since this can cause lost adhesion to the nose as well as leaving unsightly adhesive on the skin (see Anderson at column 3, lines 56-62 and column 4, lines 31-37). The encapsulated fragrances in Anderson are held on the substrate by, or within, an *adhesive* layer, such as pressure-sensitive releasable adhesives (see, column 7, lines 13-25).

There is no teaching or suggestion in Anderson to facilitate contact of the skin by the microcapsules of an article as claimed, nor is there any indication in Anderson that the unexpected whitening effects discovered by applicants to be associated with the specific claimed article are even achievable. Instead the teachings of Anderson are directed to articles wherein the microcapsules are held against the substrate or within the adhesive. Also, in light of the teachings by Anderson to minimize residue left on the skin after application, one of skill in the art would not be motivated to modify Anderson to achieve the claimed invention nor the unexpected results discovered by applicants to be associated therewith (see for example, Examples and Rule 132 Declaration previously provided). Therefore, the claimed invention is patentable over Anderson

#### **IV. THE CLAIMED INVENTION IS PATENTABLE OVER CHARLE**

The Examiner rejected original claims 1-3, 5, 8, 14-16, 19 and 20 under 35 U. S. C. § 103 (a) as being unpatentable over GB 1, 304,375 to Charle et al. ("Charle").

Applicants respectfully submit that Charle, like Anderson fails to teach or suggest any product for application to the skin that comprises a liquid impregnate, in combination with a water-insoluble substrate, and a plurality of microcapsules comprising a microcapsule wall surrounding a liquid core, wherein the microcapsule wall comprises a polyamine, and the microcapsules are distributed about the water-insoluble substrate to facilitate contact with a user's skin.

In particular, Applicants submit that Charle is directed to a composition to be applied to the nails to remove nail enamel therefrom. Charle provides no teaching or suggestion of any material to be applied to skin, nor a specific material comprising microcapsules distributed to facilitate contact with a user's skin. For this reason alone Charle fails to render the claimed invention obvious.

Applicants further maintain that Charle fails to teach or suggest an article as claimed including a liquid impregnate as claimed, nor a microcapsule comprising polyamine as claimed, nor any teaching suggestion, or likelihood of success for achieving the unexpected results demonstrated by applicants to be associated with such combination of claimed elements (see for example, Examples and Rule 132 Declaration previously provided).

In light of the above, the rejection of Charle should be withdrawn and the claims allowed.

## **V. THE CLAIMED INVENTION IS PATENTABLE OVER SLAVCHEFF IN VIEW OF ANDERSON**

The Examiner rejected claims 1-3, 7, 8, 11, 14-16, 19 and 20 under 35 U. S. C. § 103 (a) as being anticipated by U.S. patent 6, 270,783 to Slavcheff et al. ("Slavtcheff") alone or in view of Anderson. More specifically, the Examiner asserted that "polyamine microcapsules...are extremely well-known encapsulates, are commercially available, and are present in scores of skin treating compositions....[i]tis not inventive to combine well-known encapsulates with a composition containing an encapsulated material."

Applicants respectfully disagree and submit that Slavtcheff fails to teach or suggest the claimed invention for all of the reasons submitted previously. Moreover, applicants submit there is no teaching, suggestion, or likelihood of success in the cited documents for achieving the

unexpected results demonstrated by applicants to be associated with such combination of claimed elements including the particularly claimed microcapsules as compared to other well-known microcapsules (see for example, Examples and Rule 132 Declaration previously provided).

It has long been recognized that “[e]vidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art can rebut a *prima facie* case of obviousness.” MPEP716.02(a) (II). Also, “[e]vidence that a compound is unexpectedly superior in one of a spectrum of common properties...can be enough to rebut a *prima facie* case of obviousness.” *Id.* citing *In re Chupp*, 816 F.2d. 643.

The cited documents disclose a wide variety of encapsulation and microcapsule types suitable for coating a variety of materials. However, there is no teaching or suggestion therein that the particularly claimed microcapsules can be used in an article of the claimed invention to provide a whitening effect to the skin, nor that such claimed microcapsules would demonstrate the significantly improved whitening effect over any other well-known microcapsules, as shown by applicants. Therefore, applicants respectfully submit that even if a *prima facie* case of obviousness were achieved (which applicants do not believe), nevertheless, such would be overcome by the clear unexpected results found by applicants to be associated with the particularly claimed microcapsules in the claimed invention.

Therefore, the rejections should be withdrawn and the claims allowed.

